

Appln. No. 10/529,990

Attorney Docket No. 10808-228

II. Remarks

Reconsideration and re-examination of this application in view of the above amendments and the following remarks is herein respectfully requested. Claims 1-11 and 19 remain pending. Claims 12-18 have been withdrawn.

Claim Objections

Claims 1 and 3 have been amended to overcome the objections listed by the examiner. In claim 1, the duplicate "insulating" has been removed. In claim 3, the phrase "the electrode region remote from the insulating region comprises a metal" has been removed.

Claim Rejections - 35 U.S.C. §102(b)

Claims 1-9 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Application 2002/0125536 to Iwasa et al. (Iwasa).

The examiner bears the burden of providing a *prima facie* case of anticipation. MPEP §2131 provides, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. C. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites "wherein the electrode region near the insulating region is a monocrystalline region containing a multiplicity of webs" In the Iwasa reference the protrusion that the examiner refers to as the web is not contained in the



BRINKS HOFER GILSON & LIONE
PO Box 10395
Chicago, IL 60610

Appln. No. 10/529,990

Attorney Docket No. 10808-228

electrode region of the capacitor and accordingly this element is clearly not shown in the citations provided by the examiner.

Claim 1 also recites "an electrode region remote from the insulating region" and "a plurality of control electrodes". The examiner refers to element 25c as both "the electrode region remote from the insulating region" and "the plurality of control electrodes". Therefore, the examiner's use of same element in the reference to satisfy two non-corresponding elements in the claims is improper.

Further, claim 1 recites "a connecting region electrically connects the control electrodes, the connecting region is isolated from the channel region by a thick insulating region, the thick insulating region has an insulating thickness which is greater than a thickness of control electrode insulation regions". In this instance the examiner is referring to two very separate embodiments of the Isawa reference. The connecting region referred to by the examiner in Figure 8c does not have a corresponding structure in Figure 5 or Figures 6A-B. Conversely, the embodiment of Figure 8c does not provide the capacitor arrangement according to claim 1. Rather Figure 8c uses a separate capacitor arrangement 27 that interacts that does not correspond to either Figure 5 of Isawa or claim 1 of the present invention. In addition, it is not clear from the citations referred to by the examiner that element 131 referred to by the examiner as the thick insulating layer electrically connects the control electrodes.



BRINKS HOFER GILSON & LIONE
PO Box 10395
Chicago, IL 60610

Appln. No. 10/529,990

Attorney Docket No. 10808-228

Since, each and every element of claim 1 is not taught by the reference, Isawa cannot anticipate the present invention under 35 U.S.C. §102(b) as the examiner contends.

Further, claims 2-9, 11, and 19 depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

Claim Rejections - 35 U.S.C. §103(a)

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Application 2002/0125536 to Iwasa et al. (Iwasa).

Claim 10 depends from claim 1 and is, therefore, patentable for at least the same reasons as given above in support of claim 1.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted by,

Dated: July 11, 2006

Robert K. Fergan
Robert K. Fergan
Reg. No.: 51,674
Attorney for Applicant(s)

BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(734) 302-6000



BRINKS HOFER GILSON & LIONE
PO Box 10395
Chicago, IL 60610